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PATENT

Attorney Docket No. BBC-059A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:
Arnold, L.D. et al.

APPLICATION NO.: **09/831,859**

FILED: **December 3, 2001**

FOR: **The Inhibition of the Formation of Vascular Hyperpermeability**

EXAMINER: Aulakh, Charanjit
ART UNIT: 1625

I hereby certify under 37 CFR 1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.
Date of Deposit May 30, 2002
Lisa Rasmussen
Lisa Rasmussen

Commissioner for Patents
Washington, D.C. 20231

Sir:

REPLY UNDER 37 C.F.R. §1.111

This is in reply to the Office Action mailed April 30, 2002, the period for response thereto having been set to expire on May 30, 2002.

Reconsideration of the Office Action mailed April 30, 2002, (hereinafter "instant Office Action"), and withdrawal of the restriction requirement directed to claims 1-29, are respectfully requested.

In the instant Office Action, claims 1-29 are listed as pending and claims 1-29 are subject to restriction and/or election requirement.

The Examiner has required restriction of claims 1-29 under 35 U.S.C. §121 and 35 U.S.C. §372 to one of Groups I to V as listed at pages 2-3 of the instant Office Action. Applicants respectfully traverse the restriction requirement. However, to be fully responsive to the restriction requirement, Applicants provisionally elect with traverse to prosecute the claims drawn to claims 1-29 of Group I.

The Examiner alleges that the inventions listed as Groups I through V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features. The Examiner further alleges that there is

no common core which in Markush Paractice is a significant structural element shared by all of the alternatives. Applicants respectfully submit that the restriction requirement is improper under M.P.E.P. §1893.03(d), which specifically explains the "unity of invention" practice which is applicable in international applications (both Chapter I and II) and in national stage applications filed under 35 U.S.C. §371, (which the instant application is, see the instant application's claim of benefit under 35 U.S.C. 120 to PCT Application No. PCT/US99/25903). Applicants stress that the International Preliminary Examining Authority (IPEA) has already applied the **same standards** for unity of invention as the Examiner is suppose to apply to the instant application, and the IPEA did not find that unity of invention was lacking during the international stage of this application.

Applicants submit that the restriction requirement is not in compliance with "unity of invention" practice.

Unity of invention practice is governed by PCT Rule 13, more specifically Rule 13.1, which requires that for unity of invention:

> The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention").

Applicants respectfully point out that the single inventive concept of all of the therapeutic agents listed in claims 1-29 is that they inhibit vascular hyperpermeability by inhibiting the cellular signaling function of KDR (see page 8, lines 9-10 and page 9, line 31 to page 10, line 8 of the specification). A variety of compounds have the requisite KDR tyrosine kinase inhibition property described in the instant application, including antibodies, peptides, organic molecules, KDR-specific ribozymes, antisense polynucleotides or intracellular single chain antibodies. Thus, all of the aforementioned compounds fall within the inventive concept of the instant application.

With respect to the Examiner's allegation that "there is no common core which in the Markush Practice, is a significant structural element shared by all of the alternatives", Applicants direct the Examiner's attention to PCT Rule 13.2 which states:

> Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features.

The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. (emphasis added)

Applicants respectfully point out that the technical feature that defines claims 1-29 of the instant application is the ability to inhibit vascular hyperpermeability by selectively inhibiting the cellular signaling function of KDR. As stated on page 9, line 35 through page 10, line 13, the methods claimed in the instant application should afford better toleration to therapy than current therapies or treatment with agents that less selectively disrupt the function of other non-KDR kinases.

Based upon the foregoing, the restriction requirement should be withdrawn and all of the subject matter of claims 1-29 should be prosecuted together. Prompt and favorable action is earnestly solicited.

If the Examiner believes that there are any issues that could be resolved in a telephone conference, Applicants invite the Examiner to call Applicants' undersigned agent.

Respectfully submitted,

Gayle O'Brien

Date: May 30, 2002

Gayle B. O'Brien
Agent for Applicants
Reg. No. 48,812

Abbott Bioresearch Center, Inc.
100 Research Drive
Worcester, MA 01605
(508) 688-8053